

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-11 are pending in the present application. Claims 1 and 3-9 have been amended. Claims 10 and 11 are newly presented.

The Abstract of the disclosure was objected to in the Official Action on the basis that it was too long. Accordingly, the Abstract has been amended to be less than 150 words and fifteen lines in length.

Claims 1 and 9 have been amended to correct the objections set forth in the Official Action (pages 2 and 3). The suggestions made in the Official Action have been incorporated into the Claims 1 and 9.

Turning to the rejection of Claims 5-8 under 35 U.S.C. §112, second paragraph, as being indefinite, Claims 5-8 have been amended as suggested in the Official Action (page 4). Accordingly, the rejection of Claims 5-8 under 35 U.S.C. §112, second paragraph, should be withdrawn.

Turning to the rejection of Claims 3 and 4 under 35 U.S.C. §112, first paragraph, the claims were rejected on the basis that the specification does not enable any person skilled in the art to which it pertains or to which it is mostly connected to make the invention commensurate in scope with these claims. Specifically, the Official Action asserts (pages 3 and 4) that although the specification is enabling for VdAv as “the average of Abbe numbers of the lenses having positive refractive power subsequent to and including the second lens of the first lens group” the Official Action asserts that the specification does not reasonably provide enablement for VdAv as “the average of the Abbe numbers of the lenses having positive refractive power subsequent to the second lens in the first lens group.”

At the outset, Applicants note that the language “subsequent to” and “including the second lens in a first lens group” by necessity includes more than just the second lens in a first lens group, but also subsequent lenses. In addition, Applicants note that the standard for an enablement rejection is to show that one of ordinary skill in the art would not be able to make and use the invention as described in the specification without undue experimentation. See MPEP § 706.03 (c) and 2164.01. The Official Action does not provide any assertions that undue experimentation would be required to make and use the invention of Claims 3 and 4. Even if the Official Action is correct that Example 1 of Table 13 on page 39 of the specification provides an example relating to the second lens of the first lens group, this does not address the issue of whether subsequent lenses are enabled. In any event, Applicants point out that at least paragraphs [0013] and [0038] provide support for the language found in Claims 3 and 4. Accordingly, Applicants request that the rejection of Claims 3 and 4 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Before turning to the rejection of Claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Mihara in view of Nakayama, Applicants note that Claims 1 and 9 have been amended to clarify that the third lens group is fixed and that the fourth lens group is moved wherein the fourth lens group moves in one direction when the second and fourth lens groups are moved for zooming. Basis for this change to the claims can be found in at least paragraphs [0010] and [0014] of the specification, as well as Figure 1. No new matter has been added.

Turning to the rejection of Claims 1-9 as being unpatentable over Mihara publication 2006/0158742 in view of Nakayama, U.S. Patent 5,847,882, Applicants note that the Official Action takes the position that in Mihara the second and third lens groups moved for zooming with the fourth lens group fixed as shown in Figure 24 of the eighth embodiment, paragraphs [0365] and [0371], but that Mihara does not disclose the second and fourth lens groups

moving for zooming with the third lens group fixed as claimed. To overcome this deficiency of Mihara, the Official Action turns to Nakayama for teaching of a zoom lens system that is desirable to have the second and fourth lens groups moved for zooming while the third lens is fixed for the purpose of providing a zoom lens system of the simplified zooming means and improved space efficiency. The Official Action relies on column 2, lines 31-52 and column 5, lines 40-51.

Applicants note that in Nakayama, as shown for example in Figures 1 and 2 and column 5, lines 40-53, the fourth lens is moved towards the object to form a concave locus facing the object. Looking at Figure 1, it is clear that the lens moves in a curved fashion. In independent Claims 1 and 9 as amended, the claims make clear that the fourth lens group moves in one direction when the second and fourth lens groups are moved for zooming. This is different from the disclosure of Nakayama. Thus, even if Mihara and Nakayama were combined, the combined teachings and suggestions of the two references would not arrive at the claimed invention. In addition, newly presented Claims 10 and 11 point out that the fourth lens group moves in a linear noncurved fashion which further distinguishes from the teachings of Mihara and Nakayama. Applicants add that the fixed third lens group and movable fourth lens group contribute to providing large magnification and a slim lens system.

From all of the above, Applicants request that the rejection of Claims 1-9 be withdrawn and that Claims 1-11 be allowed.

Respectfully submitted,

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